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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86150854
Applicant	K & N Distributors
Applied for Mark	NEOPLUS GEL
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	
K & N Distributors	:	
	:	
Serial No.: 86/150,854	:	Examining Attorney: C. S. Young
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Filed: December 23, 2013	:	
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Mark: NEOPLUS GEL	:	Law Office: 117
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**BRIEF OF THE APPLICANT**

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## **I. INTRODUCTION**

COMES NOW the Applicant K & N Distributors (hereinafter “Applicant”), by counsel Matthew H. Swyers, Esq., The Trademark Company, PLLC, and submits the instant Brief of the Applicant in support of Applicant’s contention that the instant mark should be permitted to register.

## **II. STATEMENT OF THE CASE**

On or about December 23, 2013 K & N Distributors applied to register the trademark NEOPLUS GEL in connection with “cosmetics” in International Class 03. The application was filed as an intent-to-use application under Section 1(b) of the Act. Moreover, the application included a voluntary disclaimer of the term GEL.

On March 28, 2014 the Office conducted its initial review of the application. At that time the Office refused registration of the Applicant’s trademark on the grounds that, if registered, applicant’s trademark would create a likelihood of confusion with U.S. Registration Nos. 2582466, NEO PLUS used on or in connection with the following goods in International Class 03: “all purpose preparations for cleaning, washing and scrubbing, namely, face cleansing products, namely cleansing gel, tonic lotion, scrub; products for face care, namely, day cream, night cream, eye cream/gel, nourishing cream, anti-age/anti-wrinkle cream, serum, anti-wrinkle eye cream, moisturizer, mask.” The registrant of this service mark is listed as Neo Plus Skin Care Technology Inc.

On or about September 29, 2014 Applicant, by Counsel, submitted a response. The examining attorney, being unpersuaded by the argument, issued a Final refusal on or about November 6, 2014. The instant brief now timely follows.

### **III. ARGUMENT IN SUPPORT OF REGISTRATION**

#### **The Standard for a Determination of a Likelihood of Confusion**

A determination of likelihood of confusion between marks is determined on a case-specific basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The examining attorney is to apply each of the applicable factors set out in *In re E.I. du Pont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant *du Pont* factors are:

- (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) the similarity or dissimilarity and nature of the services as described in an application or registration or in connection with which a prior mark is in use;
- (3) the similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) the conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing;
- (5) the number and nature of similar marks in use on similar services; and
- (6) the absence of actual confusion as between the marks and the length of time in which the marks have co-existed without actual confusion occurring.

*See id.*

The examining attorney is required to look to the overall impression created by the marks, rather than merely comparing individual features. *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1029, 10 USPQ2d 1961 (2d Cir. 1989). In this respect, the examining attorney must determine whether the total effect conveyed by the marks is confusingly similar, not simply whether the marks sound alike or look alike. *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1870 (10<sup>th</sup> Cir. 1996) (recognizing that while the dominant portion of a mark is given greater weight, each mark still

must be considered as a whole)(citing *Universal Money Centers, Inc. v. American Tel. & Tel. Co.*, 22 F.3d 1527, 1531, 30 USPQ2d 1930 (10th Cir. 1994)). Even the use of identical dominant words or terms does not automatically mean that two marks are similar. In *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442 (8th Cir. 1987), the court held that “Oatmeal Raisin Crisp” and “Apple Raisin Crisp” are not confusingly similar as trademarks. Also, in *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1874 (10<sup>th</sup> Cir. 1996), marks for “FirstBank” and for “First Bank Kansas” were found not to be confusingly similar. Further, in *Luigino’s Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark “Lean Cuisine” was not confusingly similar to “Michelina’s Lean ‘N Tasty” even though both marks use the word “Lean” and are in the same class of services, namely, low-fat frozen food.

Concerning the respective goods or services with which the marks are used, the nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration. *See, e.g., Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). *See generally* TMEP § 1207.01(a)(iii).

If the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are similar



confusion is not likely. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.*, lamps, tubes) related to the photocopying field). *See generally* TMEP § 1207.01(a)(i).

Moreover the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). However, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion. *See generally* TMEP § 1207.01(d)(vii).

Applying the legal standards as enumerated above, it is clear that confusion is not likely to exist and Applicant's mark is entitled to register despite the existence of the cited mark.

***A. Dissimilarity In the Marks' As to Their Respective Appearances***

The Applicant applied to register the mark NEOPLUS GEL. The cited mark is NEO PLUS (U.S. Reg. No. 2582466.) Copies of the applications for Applicant's mark and for the blocking mark are attached hereto as Exhibits 1 – 2, respectively. (*See* Exhibits 1 - 2.)

From an initial context, Applicant must concede the phonetic equivalence of NEOPLUS versus NEO PLUS. Moreover, as the Applicant has disclaimed GEL apart from its mark as a whole, Applicant must concede the highly similar nature of the first cited trademark against its mark.

Generally, the existence of third-party registrations cannot justify the registration of another mark that is similar to a previously registered mark as to create a likelihood of confusion, or to cause mistake, or to deceive. *E.g.*, *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009). However, third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, *or so commonly used that the public will look to other elements to distinguish the source of the goods or services*. See, *e.g.*, *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012)(*emphasis added*); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911-12 (TTAB 1988); *Plus Prods. v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983). In the case with the NEOPLUS GEL mark, the term NEO has consistently been treated as weak with respect to similar goods, therefore consumers must rely on other factors, in this case the addition of the word GEL to the mark, as well as the differences in goods, trade and marketing channels to be distinguished.

There can be no doubt that both the Applicant's mark and that of the Registrant contain the terms, or phonetic equivalent thereto the term "NEO" In this regard, Applicant respectfully submits the following Exhibits 3 through 17 (previously made of record in Applicant's office action response) which display 14 registered marks incorporating the term "NEO" and literal equivalents thereof used in relation to similar goods. The marks are as follows:

NEO PEEL, U.S. Reg. No. 4258154 owned by Neocutis S.A., used in connection with "Non-medicated skin care preparations, namely, creams, lotions, gels, toners, cleaners and peels." in International Class 03. See Exhibit 3;

NEOTENSIL, U.S. Reg. No. 4545028, owned by Living Proof, Inc., used in connection with "Cosmetics and cosmetic preparations; non-medicated toiletries; non-medicated skin care preparations" in International Class 03. See Exhibit 4;

NEOCALM, U.S. Reg. No. 3954940, owned by Lancome Parfums et Beaute & Cie L'Oréal, used in connection with “Cosmetics, namely, creams, milks, lotions, gels and powders for the face, the body and the hands; non-medicated sun care preparations; makeup preparations; shampoos; hair care and hair styling preparations, namely, gels, sprays, mousses and balms; hair lacquers; hair coloring and hair decolorant preparations; permanent waving and curling preparations; essential oils for personal use” in International Class 03. *See* Exhibit 5;

NEOPEARL, U.S. Reg. No. 4434511, owned by Cosmétiques France-Laure (1970), used in connection with “Soaps for hands, face and body; perfumes, essential oils, cosmetics, hair lotions; dentifrices; depilatory preparations; make-up remover; lipstick; beauty masks” in International Class 03. *See* Exhibit 6;

NEOSHELL, U.S. Reg. No. 4434502, owned by CAPSUM SAS FRANCE Bâtiment C 3, used in connection with “Soaps for hands, face and body; perfumes, essential oils, cosmetics, hair lotions; dentifrices, depilatory preparations; Make-up removers; lipstick; beauty masks” in International Class 03. *See* Exhibit 7;

NEOBRIGHT, U.S. Reg. No. 4359739, owned by POLLOGEN LTD, used in connection with “Cosmetic creams, face and body creams” in International Class 03. *See* Exhibit 8;

NEOMIST, Reg. No. 4252245, owned by NeoVix Société à responsabilité limitée, used in connection with “Perfumes, essential oils, cosmetics, hair lotions; dentifrices; depilatory preparations; make-up removing preparations; creams for leather” in International Class 03. *See* Exhibit 9;

NEOCLAIM, U.S. Reg. No. 4100799, owned by KHROME Société à responsabilité limitée, used in connection with “Soaps for personal use; perfumes, essential oils, cosmetics, hair lotions; depilatory preparations; make-up removing preparations; lipsticks; beauty masks; shaving preparations” in International Class 03. *See* Exhibit 10;

NEODERMA, U.S. Reg. No. 4378054, owned by Rolandos Enterprises Public Limited, in connection with “Soaps; perfumery; essential oils; cosmetics; cosmetic skin, body, and hair care creams; cosmetic preparations for slimming purposes; astringents for cosmetic purposes; cosmetic preparations for baths; lotions for cosmetic purposes; pomades for cosmetic purposes; cosmetic preparations for skin care; cleansing milk for toilet purposes; hair lotions; dentifrices; sprays for refreshing and cleaning the skin; cosmetic sun-tanning preparations; make-up preparations; make-up removing preparations; perfumery, namely, deodorants for personal use; toilet waters; scented linen waters; oils for toiletry purposes; perfumed oils for skin care; preparations for shaving; aftershave lotions; beauty masks; antiperspirants; bath salts, not for medical purposes;

prepared wax for depilation; body care products, namely, body lotion; non-medicated massage preparations, namely, massage creams and oils; cosmetic lotions for care of skin” in International Class 03. *See* Exhibit 11;

NEOCLEAR, U.S. Reg. No. 3902074 owned by MITCHELL GROUP USA LLC, used in connection with “Medicated soaps” in International Class 03, and “Medicated lotions for skin; Medicated skin care preparations” in International Class 05. *See* Exhibit 12;

NEOTONE, U.S. Reg. No. 3898976, owned by Isis Pharma GmbH gesellschaft mit beschränkter haftung (gmbh), used in connection with “Cosmetic products, namely, lotion and creams for skin care” in International Class 03. *See* Exhibit 13;

NEOFRESH, U.S. Reg. No. 3998556, owned by SYMRISE AG AKTIENGESELLSCHAFT FED REP GERMANY, used in connection with “perfumery, essential oils for personal and household use; essential oils for use in the manufacture of scented products; scents and perfume substances for laundry use, namely, detergents, bleaches and fabric softeners; body soaps; cosmetics; hair lotions; dentifrices; non-medicated mouth care products, namely, toothpaste and mouthwash; processed natural resins for use as a fragrance.” In International class 03. *See* Exhibit 14;

NEO MOVE, U.S. Reg. No. 3530204, owned by L'Oreal SOCIÉTÉ ANONYME, used in connection with “Shampoos; gels, sprays, mousses, balms for hair styling and hair care; hair lacquers; hair colouring and hair decolorant preparations; permanent hair waving and hair curling preparations; hair strengthening preparations; essential oils for personal use” in International Class 03. *See* Exhibit 15;

NEO, U.S. Reg. No. 3323783, owned by Parfums Givenchy S.A., used in connection with “[ Toilet soaps; ] perfumes, eaux de cologne and eaux de toilette; [ cosmetics; essential oils for personal use; milks, lotions, creams, emulsions and cosmetic gels, all for face and body care; personal deodorants ]” in International Class 03. *See* Exhibit 16;

NEO BODY SPA U.S. Reg. No. 3421658, owned by ade Distribution Inc, used in connection with “Non-medicated skin care preparations; hair care preparations; shower gel; bath salts; body wash.” in International Class 03. *See* Exhibit 17.

Accordingly, based upon consideration of the dilution of the term “NEO” and literal and phonetic equivalents thereof as it relates to marks in related classes, Applicant respectfully submits that this *du Pont* factor favors a finding of an absence of a likelihood of confusion

between the marks and merely requests the Board to ratify the instant refusal by determining that the Applicant's mark is simply not sufficiently similar to the registration.

***B. Dissimilarities Between the Trade Channels for the Marks***

Applicant's cosmetic gel bearing the NEOPLUS GEL mark will be widely offered in the make-up and cosmetics aisles of stores such as grocery stores and pharmacies, and will be available on our website. In contrast, it appears that the trade channels of the goods bearing the NEO PLUS mark are offered in very specific locations, namely physician offices and medical spas, as shown on Registrant's website. The goods sold under the NEO PLUS mark do not appear available for purchase on-line. *See* Exhibit 18 previously made of record in Applicant's office action response.

As such, it is respectfully submitted that Applicant's goods travel in a channel of trade diverse from those for the goods of the cited mark. Moreover, as the evidence of record indicates that the Applicant's channel of trade for its goods are completely distinct from the goods of the cited mark, it is submitted that their respective goods would not be encountered by the same persons in situations that would create the incorrect assumption that such goods originate from the same source and, accordingly, this *du Pont* factor also favors registration of the Applicant's mark.

***C. Sophistication of the Purchasers and Members of the Respective Goods***

The blocking mark's cosmetics are designed to attract a very sophisticated, namely, consumers visiting a medical spa or a physician's office for skin care needs. The goods under the blocking mark are professional grade, as evidenced by Registrant's website, and as such are assumed to be more expensive than that of the cosmetics sold under the NEOPLUS GEL mark,

which will be available in the cosmetic aisles of stores such as grocery stores and pharmacies. *See* Exhibit 18 previously made of record.

As such, the average purchaser of the respective goods offered under the cited mark would exercise a high level of sophistication in choosing the cited mark's goods as apart from the goods of the Applicant's mark, therefore minimizing any likelihood of confusion. *See* TMEP § 1207.01(d)(vii).

Accordingly, it is also submitted that this *du Pont* factor favors a finding of an absence of a likelihood of confusion as between Applicant's mark and the cited marks.

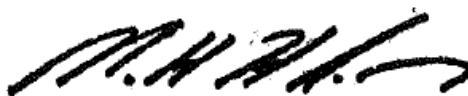
#### IV. CONCLUSION

In conclusion, based upon the foregoing it is submitted that the *du Pont* factors addressed herein favor registration of the Applicant's mark. The marks themselves are distinct and do not travel in similar trade channels such that they would be encountered by the same class of purchasers or members.

WHEREFORE it is respectfully requested that the board review the file of the instant proceedings, remove as an impediment the cited mark, and approve the instant application for publication upon the Principal Register.

Respectfully submitted this 9<sup>th</sup> day of January, 2015

THE TRADEMARK COMPANY, PLLC



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